

REMARKS

The indication of allowable subject matter in claims 6, 7 and 14 is acknowledged and appreciated. In view of the following remarks, it is respectfully submitted that all claims are in condition for allowance.

Claims 1-5 and 13 stand rejected under 35 U.S.C. § 102 as being anticipated by Applicants' admitted prior art (AAPA). Claim 1 is independent. This rejection is respectfully traversed for the following reasons.

Claim 1 recites in pertinent part, "bonding a surface protection tape to the wafer using an adhesive material *which contacts the passivation film ...*" (emphasis added). New claim 15 similarly recites "bonding a surface protection tape to the wafer using an adhesive material which contacts the passivation film" According to one aspect of the present invention, in view of the aforementioned feature of the adhesive material, contamination of the wafer surface by permeation of, for example, a polishing slurry can be prevented. In direct contrast, the alleged adhesive material 320 of AAPA is expressly disclosed as NOT contacting the alleged passivation film 306 (*see, e.g.*, Figure 21B of Applicants' drawings).

As anticipation under 35 U.S.C. § 102 requires that each and every element of the claim be disclosed, either expressly or inherently (noting that "inherency may not be established by probabilities or possibilities", *Scaltech Inc. v. Retec/Tetra*, 178 F.3d 1378 (Fed. Cir. 1999)), in a single prior art reference, *Akzo N.V. v. U.S. Int'l Trade Commission*, 808 F.2d 1471 (Fed. Cir. 1986), based on the forgoing, it is submitted that AAPA does not anticipate claims 1 and 15, nor any claim dependent thereon.

Under Federal Circuit guidelines, a dependent claim is nonobvious if the independent claim upon which it depends is allowable because all the limitations of the independent claim are

Application No.: 10/607,274

contained in the dependent claims, *Hartness International Inc. v. Simplimatic Engineering Co.*, 819F.2d at 1100, 1108 (Fed. Cir. 1987). Accordingly, as claim 1 is patentable for the reasons set forth above, it is respectfully submitted that all claims dependent thereon are also patentable. In addition, it is respectfully submitted that the dependent claims are patentable based on their own merits by adding novel and non-obvious features to the combination. Based on the foregoing, it is respectfully submitted that all pending claims are patentable over the cited prior art. Accordingly, it is respectfully requested that the rejection under 35 U.S.C. § 102 be withdrawn.

CONCLUSION

Having fully and completely responded to the Office Action, Applicants submit that all of the claims are now in condition for allowance, an indication of which is respectfully solicited. If there are any outstanding issues that might be resolved by an interview or an Examiner's amendment, the Examiner is requested to call Applicants' attorney at the telephone number shown below. To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made.

Application No.: 10/607,274

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

McDERMOTT WILL & EMERY LLP



Ramyar M. Farid
Registration No. 46,692

600 13th Street, N.W.
Washington, DC 20005-3096
Phone: 202.756.8000 RMF:ajb
Facsimile: 202.756.8087
Date: May 15, 2006

**Please recognize our Customer No. 20277
as our correspondence address.**